

Response

Applicants, through their attorney, respectfully request the Examiner to reconsider and withdraw the outstanding rejections of the claims for the reasons set forth below.

Support

Applicants have amended claim 1 to specify that the average carbon length of the mixture of alcohols referred to in the claims is from 10.4 to 11.3. Support for this amendment is found on page 12 of the specification. See the table at the top of page 12 where Inventive Examples having an ACL of 10.4 and 11.3 are provided, thus supporting a claimed range of 10.4 to 11.3 for the ACL.

No other elements of the claims have been changed.

Remarks

The Examiner rejected claims 1-17 under 35 U.S.C. 103(a) as being unpatentable over Lal (EP 0626442). The current rejections are based solely on Lal.

The Examiner maintains that Example B-9 of Lal, which when calculated would have an ACL of 11.7, is too close to an ACL value of 11.6 to be considered a different value, and as such, the example in Lal is falls within the previously claimed range of 10.4 to 11.6. Furthermore the Examiner has found Applicants previous selection arguments to be unpersuasive specifically because an example of cited reference fell within the previous claims. The Examiner also noted that the data provided may not be commensurate in scope with regards to the esterified polymer of the claims.

Applicants continue to disagree with the Examiner's application of Lal. However in the interests of moving the case forward Applicants have amended the claims to further specify the range of ACL values.

The current claims now specify an ACL of 10.4 to 11.3. The B-9 Example of Lal, with an ACL of 11.7, is now clearly outside of the scope of the current claims. Furthermore, the comparative examples in the specification, having an ACL of 9.1 and 12.8, are fair representatives of the teachings of Lal. The reference provides no direct teaching of ACL or its impact on performance. In addition, the examples in Lal have ACL values, when calculated, that are all well above the upper or below the limits of the currently claims range.

Applicants respectfully submit that none of the examples of the cited reference fall within the scope of the current claims and that the present invention show surprising results

not taught by the reference. Therefore the present claims are not novel and non-obvious over the reference and ask that the current rejections be removed.

If the Examiner still feels the claims are too broad with regards to the esterified copolymer, Applicants note that MPEP §2145 states in part (*emphasis added*):

When considering whether proffered evidence is commensurate in scope with the claimed invention, ***Office personnel should not require the applicant to show unexpected results over the entire range of properties possessed by a chemical compound or composition.*** See, e.g., *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). ***Evidence that the compound or composition possesses superior and unexpected properties in one of a spectrum of common properties can be sufficient*** to rebut a *prima facie* case of obviousness. *Id.*

For example, a showing of unexpected results for a single member of a claimed subgenus, or a narrow portion of a claimed range would be sufficient to rebut a *prima facie* case of obviousness if a skilled artisan "could ascertain a trend in the exemplified data that would allow him to reasonably extend the probative value thereof." *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980) (Evidence of the unobviousness of a broad range can be proven by a narrower range when one skilled in the art could ascertain a trend that would allow him to reasonably extend the probative value thereof.).

In addition to providing examples across the claimed range, including comparative examples outside of the claimed range, the inventive examples in the specification are derived from a representative copolymer, specifically a maleic anhydride-styrene copolymer. There is no reason to believe that copolymers derived from alpha-olefins instead of styrene would impact the importance of the ACL parameter, nor is there any reason to believe the use of other acids would change the results.

Furthermore Applicants have previously amended the claims to specify that the esterified copolymer is derived from an alpha, beta-unsaturated dicarboxylic acid or anhydride. The inventive example uses a dicarboxylic anhydride representative of such materials. Therefore, in light of the present amendments and for the reasons stated above, Applicants respectfully submit that the present claims are commensurate in scope with the data in the specification and ask that the claims be allowed.

Even if the Examiner finds these arguments to be unpersuasive, Applicants note that claims 6 and 7 further limit the esterified copolymer. These claims at least should be found allowable.

USSN 10/571,741
Amendment and Response

Conclusion

For the foregoing reasons it is submitted that the present claims are novel and unobvious over the cited reference, and in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore an early and favorable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the Undersigned is suggested.

Any required fees or any deficiency or overpayment in fees should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,
THE LUBRIZOL CORPORATION

/Christopher D. Hilker #58,510/

Christopher D. Hilker
Registration No. 58,510
Attorney for Applicants

29400 Lakeland Blvd.
Wickliffe, Ohio 44092-2298
Telephone: 440-347-4231
Facsimile: 440-347-1110
E-mail: chris.hilker@lubrizol.com